

REMARKS

Claims 1-34 are pending in the Application. Claims 14, 15, 17 and 24 are cancelled herein without prejudice. Claims 1-13, 16, 18-23, 25-27, 31 and 33-34 are amended herein. Entry of the above amendments to the Specification and the Claims is respectfully requested. The amendments, which are discussed in more detail below, do not add any new matter and are fully supported in the Specification as originally filed.

Objections to the Specification:

The Examiner has suggested that the spelling of "immobilizing" in Claim 33 be corrected. Claims 33 has been amended to correct the spelling.

The Examiner has also required that the Applicants, under MPEP § 608.01, delete the embedded hyperlink and/or other form of browser-executable code found in the Specification (see, *e.g.*, "http://www.biocore.com" on page 8).

Applicants have amended each and every occurrence of a potential hyperlink in the Specification. In particular, Applicants have amended the potential hyperlink on page 8, line 19, to read as "WorldWideWeb.biocore.com"; the potential hyperlink at page 16, line 14, to read as "WorldWideWeb.acs.org"; and the potential hyperlink at page 29, line 7, to read as "WorldWideWeb.biocore.com". Applicants respectfully submit that these amendments render the representative websites non-executable by current browsers and are therefore acceptable under MPEP § 608.01.

Rejection of Claims 17, 33 and 34 under 35 U.S.C. 112, ¶ 2:

The Examiner has rejected Claims 17, 33 and 34 under 35 U.S.C. 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner contends the following:

- 1) The definition of R^7 in Claim 17 is not a definition of R^7 as recited in Claim 1 (from which Claim 17 ultimately depends).
- 2) The phrase "for example" in Claim 34 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

3) Claims 33 and 34 are indefinite in that there is no step recited in each claim whereby the recited steps are correlated with the "method for identifying a binding partner" as recited in the preamble of the claims.

With respect to item 1) above, Applicants submit that the term "heteroalkyl" (which is defined to cover the carbonyl part of the R⁷ definition) is intended to include heteroalkyl groups which are optionally substituted, for example, by aryl, heteroaryl or heterocyclyl groups. However, in the interest of furthering the prosecution of this application to issuance, Claim 16 is amended to be independent and to have the definition of R⁶ and R⁷ as set forth in Claim 17. Claim 17 is cancelled as being redundant to amended Claim 16. Applicants submit that amended Claim 16 is fully supported in the Specification as originally filed.

With respect to item 2) above, the phrase "for example by gentle washing with aqueous buffer" is deleted from Claim 34.

With respect to item 3) above, the phrase "wherein the method comprises" is inserted after "claim 1" in Claim 33 and Claim 34. In addition, Claim 33 and Claim 34 are amended to clarify the relationship of the desired result of the claimed process with the components used in the process. These amendments are fully supported in the Specification as originally filed.

Applicants respectfully submit that the rejections of Claims 17, 33 and 34 under 35 U.S.C. 112, ¶ 2, are now overcome and respectfully request allowance of these Claims at an early date.

Objection of Claims 23 and 24 under 37 CFR 1.75:

The Examiner has objected to Claims 23 and 24 as being duplicate claims. Claim 24 is cancelled, thereby overcoming this objection.

Rejection of Claims 1-3, 9, 10, 14, 15 and 18-34 under 35 U.S.C. 102(a):

The Examiner has rejected Claims 1-3, 9, 10, 14, 15 and 18-34 under 35 U.S.C. 102(a) as being anticipated by Bianco, A. *et al.*, *J. Org. Chem.* (2000), Vol. 65, pp. 2179-2187 ("Bianco"). In particular, the Examiner contends that Bianco discloses compounds,

pharmaceutical compositions, pharmaceutical methods of use and methods of using compounds to screen for specific binding partners that fall within the scope of the instant claims.

In light of the above amendments to the Claims, Applicants traverse this rejection for the following reasons:

Claim 14 and Claim 15 are cancelled herein in light of the amendment to Claim 1 (discussed below in more detail), thereby rendering moot this rejection with respect to these Claims.

Claim 1 is amended herein to remove -OR⁵ as a choice for R⁴. In so doing, Claim 1 now reads that R⁴ can only be -NR⁶R⁷. None of the compounds disclosed in Bianco contain an amino group (*i.e.*, -NR⁶R⁷) in the position that corresponds to the R⁴ position in the compounds of Claim 1. In fact, all of the compounds disclosed in Bianco have hydroxy (*i.e.*, -OR⁵ where R⁵ is hydrogen) at that position. Applicants therefore respectfully submit that the compounds disclosed in Bianco do not anticipate the compounds of Claim 1 (as amended) or the compounds of Claims 2-3 and 9-10 (which are all dependent upon Claim 1). Furthermore, Applicants respectfully submit that the pharmaceutical compositions and methods of use that are disclosed in Bianco also do not anticipate Claim 18, which is directed to pharmaceutical compositions containing compounds of Claim 1, or Claims 19-34, which are directed to methods of using the compounds of Claim 1. In view of the foregoing remarks, Applicants respectfully request the withdrawal of the rejection of Claims 1-3, 9-10 and 18-34 under 35 U.S.C. 102(a) in view of the disclosure of Bianco.

Rejection of Claims 1, 9, 10, 14 and 15 under 35 U.S.C. 102(b):

The Examiner has rejected Claims 1, 9, 10, 14 and 15 under 35 U.S.C. 102(b) as being anticipated by Diafi, L., *et al.*, *J. Heterocyclic Chem.* (1990), Vol. 27, No. 7, pp. 2181-2187 ("Diafi"). In particular, the Examiner contends that compounds 7e and 7f of Table I in Diafi anticipate the compounds of formula (I) where n is 1 or 2, R⁴ is -OH and R¹ is aryl.

As discussed above, Claims 14 and 15 are cancelled, thereby rendering moot this rejection with respect to these claims. Also, as discussed above, Claim 1 is amended so that R⁴ can only be -NR⁶R⁷. None of the compounds disclosed in Diafi contain an amino group (*i.e.*, -NR⁶R⁷) in the position that corresponds to the R⁴ position in the compounds of Claim 1.

Applicants therefore respectfully submit that the compounds disclosed in Diafi do not anticipate the compounds of Claim 1 (as amended), or the compounds of Claim 9 (which is dependent upon Claim 1), or the compounds of Claim 10 (which is dependent upon Claim 1). In view of the foregoing remarks, Applicants respectfully request the withdrawal of the rejection of these Claims under 35 U.S.C. 102(b) in view of the disclosure of Diafi.

Objection to Claims 4-8, 11-13 and 16:

The Examiner has objected to Claims 4-8, 11-13 and 16 as being dependent upon a rejected base claim, but has stated that they would be allowable if they are rewritten in independent form including all the limitations of the base claim and any intervening claims.

Claims 4, 11 and 16 are amended herein to be in independent form, including all the limitations of the base claim and any intervening claims. Accordingly, Applicants respectfully submit that Claims 4-8 (Claims 5-8 are dependent upon Claim 4), Claims 11-13 (Claims 12-13 are dependent upon Claim 11) and Claim 16 are now in condition for allowance.

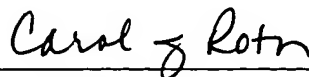
Conclusion:

In light of the foregoing amendments and remarks, Applicants respectfully submit that all objections and rejections of the Claims are now overcome and that all of the claims remaining in the application, *i.e.*, Claims 1-13, 16, 18-23 and 25-34, are now clearly allowable. Favorable consideration and a early Notice of Allowance is earnestly solicited. Applicants reserve the right to pursue cancelled claims and subject matter in a separate continuation application.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC



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